



PATENT  
Customer No. 22,852  
Attorney Docket No. 5725.0533

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                             |   |                           |
|-----------------------------|---|---------------------------|
| In re Application of:       | ) |                           |
|                             | ) |                           |
| ALAIN BETHUNE et al.        | ) | Group Art Unit: 1734      |
|                             | ) |                           |
| Application No. 09/506,795  | ) | Examiner: G. R. Koch, III |
|                             | ) |                           |
| Filed: February 18, 2000    | ) |                           |
|                             | ) |                           |
| For: MATERIAL SUPPLY STRIP, | ) |                           |
| SYSTEM, AND METHOD OF       | ) |                           |
| APPLYING PIECES OF          | ) |                           |
| MATERIAL TO OBJECTS         | ) |                           |

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO OFFICE ACTION OF NOVEMBER 18, 2003**

Applicants respectfully request reconsideration of the application and withdrawal of the claim rejections in view of the following remarks. Claims 1-26, 28-35, 72, 73, and 76 are pending. Claims 7, 11, 13, 15, 17-19, and 72 were withdrawn from consideration in view of a species election requirement.

In the Office Action, claims 1-26, 28-35, 72, 73, and 76 were rejected under 35 U.S.C. § 112, ¶ 1, for alleged noncompliance with the written description requirement. The Examiner asserted that "[n]either the specification as originally filed, or the French document incorporated by reference disclose that the pieces of material on the first surface of the supply strip backing have a different size than the pieces of material on the second surface." (Office Action at ¶ 2.) The Examiner further asserted

that "the original specification provides no support for centering the pieces of material on the first and second surface of the supply strip." (*Id.*)

Applicants respectfully disagree with this rejection because the original specification provides clear support for each of these features. For example, page 14 of the original specification discloses that "the invention could be practice[d] with labels having many different configurations (e.g., different size, different shape, different labeling information)" (emphasis added). Moreover, as acknowledged by the Examiner, the application discloses that labels on the first surface could have a different configuration (e.g., different size and/or shape) than the labels on the second surface. (Office Action at ¶ 4; application at 7, 11.) Furthermore, as also acknowledged by the Examiner, the specification "provides support for centering the pieces of material on the first and second surface of the supply strip ... ." (Office Action at ¶ 4.) Contrary to the Examiner's assertion, therefore, claims 1-26, 28-35, 72, 73, and 76 are fully supported by the original application. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, ¶ 1.

Claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76 were rejected under 35 U.S.C. § 103(a) based on the combination of DE 2 212 995 to Schafer, U.S. Patent No. 6,306,475 to Stocq et al. and JP 05-294054 ("JP '054"). Applicants respectfully disagree with this rejection because the asserted combination of the cited references fails to teach or suggest any of the claimed inventions.

Schafer discloses a label strip with labels on both sides, wherein the labels on opposing sides are staggered with respect to one another. (*See, e.g.*, Figs. 1-4.) According to Schafer, "[t]o be able to also process strips in which the labels on the two

sides of backing strip 3 have different spacings [i.e., staggered], a feed device 60 is also connected downstream from holder 52.” (Schafer translation at 11.) Thus, Schafer discloses a device specifically configured to dispense labels from a label strip having this staggered configuration shown in Figs. 1-4. Schafer does not disclose that the backing of the strip is formed of the same material as the labels.

JP '054 discloses a label strip with labels adhered to both sides of a backing, wherein the labels on both sides have the same size and are positioned directly opposed from one another so that edges of opposing labels line up exactly. (See Figs. 1, 3, and 4.) JP '054 does not disclose a backing strip formed of the same material as labels.

Stocq et al. discloses a “pressure-sensitive laminate and a method of making the same, for which the release strength between an adhesive layer and a release liner can be selectively varied after the laminate has been manufactured by exposing the interface between the adhesive layer and the release liner to ultraviolet light.” (Stocq et al., Abstract.) Stocq et al. incidentally discloses that a backing sheet could be selected from “clear polymeric films, such as those used for the face sheet” of the laminate (*id.* at col. 3, ll. 52-54), but does not teach or suggest any reason why one would make such a selection.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) based on multiple references, the Examiner must show the following: (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine teachings of the references; (2) there is a reasonable expectation or success; and (3) the teaching or

suggestion to make the claimed combination and the reasonable expectation of success are both found in the prior art and not based on applicant's disclosure. See MPEP § 2142.

Turning to the claim language, claims 1 and 76 recite that "the pieces of material on the first surface" of the supply strip backing have "a *different size* than the pieces of material on the second surface," and that "the pieces of material on the first surface are *centered* with respect to corresponding pieces of material on the second surface" (emphasis added). The Examiner has acknowledged that Schafer, the primary reference relied upon, does not teach or suggest pieces of material on a first surface of a backing centered with respect to differently-sized pieces of material on a second surface of the backing. Nevertheless, the Examiner asserted that in view of JP '054 one of ordinary skill in the art would have modified Schafer to abandon its staggered label configuration in favor of a hypothetical label strip having differently-sized labels on opposing sides of the backing centered with respect to one another.

Applicants respectfully disagree with this rejection because the asserted combination of Schafer and JP '054 fails to teach or make obvious a label strip, wherein "the pieces of material on the first surface have a different size than the pieces of material on the second surface," and wherein "the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface," as recited in claims 1 and 76. As explained above, Schafer teaches a double-sided label strip with a staggered configuration and a specially-designed feed device to process a strip with this staggered configuration. JP '054 does not provide any suggestion or motivation to modify Schafer to abandon this staggered configuration or

to use a centered configuration with labels of different sizes. Although the drawings accompanying JP '054 disclose lining up edges of opposing labels having exactly the same size, JP '054 does not generally disclose the concept of centering labels or otherwise provide any reason why one would do so. Moreover, JP '054 does not disclose or suggest using labels of different sizes on opposing sides of the label strip. If anything, JP '054 suggests using labels of exactly the same size on both sides of the backing. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 76.

With respect to claim 1, the Examiner also asserted that it would have been obvious to modify Schafer to have the backing and labels made of the same material in view of Stocq et al. since "such a selection would be available as a design choice." (Office Action at 4.) Applicants respectfully submit that the Examiner has improperly attempted to shift the burden of proving nonobviousness to the Applicants, rather than presenting a *prima facie* case of obviousness by citing one or more references that would teach or suggest the claimed invention. In particular, the Examiner has failed to cite any teaching in Stocq et al. or any other reference that would have provided any suggestion or motivation to use the same material for the labels and the backing. Mere availability of a design choice does not constitute a suggestion or motivation to use that design choice. Thus, contrary to the Examiner's assertion, the cited references do not teach or suggest this feature of claim 1. For this additional reason, Applicants respectfully request that the Examiner withdraw the rejection of claim 1.

Claims 2-5, 8-10, 12, 14, 21, 28, and 73 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., JP '054, and U.S. Patent No. 5,143,466 to Moncrieff Baldwin et al. Claim 6 depends from claim 1, and is therefore allowable for at least the same reasons as claim 1.

Claims 16, 20, and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., JP '054, and U.S. Patent No. 3,861,986 to Wochner. These claims depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Claims 22, 24-26, and 29-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., JP '054, and U.S. Patent No. 6,379,761 to Brandt et al. These claims depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Claims 23 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., JP '054, and U.S. Patent No. 5,376,417 to Amano et al. These claims depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Claim 28 was alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., JP '054, Brandt et al., and U.S. Patent No. 5,569,540 to Hirose et al. Claim 28 depends from claim 1, and is therefore allowable for at least the same reasons as claim 1.

Claims 7, 11, 13, 15, 17-19, and 72 were withdrawn from consideration as being directed to non-elected species. Because each of these claims depends from an

allowable generic claim (i.e., claim 1), Applicants respectfully request that the Examiner rejoin, examine, and allow each of these claims.

Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If a telephone conversation might advance prosecution of the application, the Examiner is invited to call Applicants' undersigned attorney at (202) 408-4197.

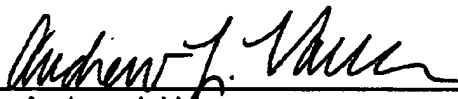
The Office Action contains characterizations of the invention, the claims, and the related art, with which Applicants do not necessarily agree. Applicants decline automatically to subscribe to any statement or characterization in the Office Action, regardless of whether it was addressed herein.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 12, 2004

By:   
Andrew J. Vance  
Reg. No. 45,174